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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/557,493	04/24/2000	John E. Tafoya	MCS-019-99	7631

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EXAMINER

NAJJAR, SALEH

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 02/23/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

PR4

Office Action Summary

Application No.

09/557,493

Applicant(s)

TAFOYA ET AL.

Examiner

Saleh Najjar

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 2157

1. This action is responsive to the Request for Continued Examination filed November 28, 2003. The amendment filed October 8, 2003 has been entered. Claims 1-2, 21, 23, 25, 29, and 30 were amended. Claims 1-32 are pending.
2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. Claims 1-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hachamovitch et al., U.S. Patent No. 6,377,965 (referred to hereafter as Hach) further in view of Creswell et al., U.S. Patent No. 6,564,264.

Hach teaches the invention substantially as claimed including an automatic word completion system for partially entered data (see abstract).

As to claim 1, Hach teaches a computer-readable medium having a computer implemented process for providing automatically generated completion information from entries in a suggestion list via a user interface, comprising using a computer to perform the following acts:

Dynamically tracking a data store of items comprising one or more of previously registered addresses in an email application's address book, and further comprising a plurality of electronic documents including one or more of word processor files, spreadsheet files, and presentation files (see col. 7-8, Hach discloses that suggestion lists are defined based on dynamic parameters maintained by the computer system including structured data field entries, e-mail address book and that the word completion system may be deployed within an individual application program such as word processor program or email program and alternatively may be deployed within an

operating system or an application independence basis such as spread sheet program or personal calendar program);

Analyzing and extracting contact information from items within the data store; adding the contact information to the suggestion list; dynamically generating suggested entries from the contact information and related to user entry data (see col. 7-8, Hach discloses that suggestion lists are defined based on dynamic parameters maintained by the computer system including structured data field entries, e-mail address book, word processor program, email program, spread sheet program and personal calendar program); and

Providing the suggested entries in the dynamic list via the user interface in real time as the user enters the data (see figs. 1-7; col. 6-8, Hach discloses a program, system and method for dynamically suggesting entries from a contact suggestion list that is updated from database files).

Hach does not explicitly teach the limitation wherein the "data store of items comprises one or more of previously sent e-mail and previously received email".

However, Creswell teaches a system, method and program for automatic address updating of outgoing and incoming user messages in a network (see abstract). Creswell discloses the claimed limitation of data store of items comprises one or more of previously sent e-mail and previously received email (see figs. 1-3; col. 3-4, Creswell discloses that a address database 30 is automatically and dynamically updated based on incoming and outgoing mail messages).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hach by including a data store of items comprising one or more of previously sent e-mail and previously received email as taught by Creswell to update a contact list at a client computer. One would be motivated to do so to keep a complete contact list based on sent and received email messages.

As to claim 2, Hach teaches the computer-implemented process of claim 1 wherein the data store further includes:

Hach does not explicitly teach the limitation wherein the data store includes "email addresses and contacts that exist within previous systems; email stores located on at least one of local and public servers; current and previous contact databases; and data embedded within other electronic application files".

However, Creswell teaches an automatic address book updating program system and method (see abstract). Creswell teaches that the data store includes "email addresses and contacts that exist within previous systems; email stores located on at least one of local and public servers; current and previous contact databases; and data embedded within other electronic application files" (see col. 3-4, Creswell discloses that several sources are queried for updating the user address book for updating contact information).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hach by including "email addresses and contacts that exist within previous systems; email stores located on at least one of local and public servers; current and previous contact databases; and data embedded within other electronic application files" in the address book as taught by Creswell. One would be motivated to do so to update and complete the contact list from diverse resources.

As to claim 3, Hach teaches the computer-implemented process of claim 1 wherein providing automatically generated completion information comprises providing a most probable match from the list to a portion of the user entry data (see col. 7-8, Hach discloses that suggested entries result from partial entry of data).

As to claim 4, Hach teaches the computer-implemented process of claim 1 wherein dynamically tracking a data store comprises scanning electronic files of at least one of particular types and in specific locations to locate contact information within the Files (see col. 7-11).

As to claim 5, Hach teaches the computer-implemented process of claim 4 wherein electronic files are scanned as they enter the data store (see col. 7-9).

As to claims 6, Hach teaches the computer-implemented process of claim 4.

Hach fails to teach the limitation wherein particular electronic files within the data store are excluded from scanning.

However, Creswell teaches an automatic address book updating program system and method (see abstract). Creswell teaches that particular electronic files within the data store are excluded from scanning (see col. 3-5, Creswell discloses that user rules are taken into account for accessing specified resources for contact information).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hach by excluding particular files from scanning. One would be motivated to do so to filter the address book information.

As to claim 7, Hach teaches the computer-implemented process of claim 4.

Hach fails to teach the limitation wherein email received from at least one of specific email addresses and Internet domains are excluded from scanning.

However, Creswell teaches an automatic address book updating program system and method (see abstract). Creswell teaches that particular electronic files within the data store are excluded from scanning (see col. 3-5, Creswell discloses that user rules are taken into account for accessing specified resources for contact information).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hach by excluding emails from scanning. One would be motivated to do so to filter the address book information.

As to claim 8, Hach teaches the computer-implemented process of claim 1 wherein analyzing and extracting contact information from items within data store comprises: locating at least one of email addresses and contact information in the items; copying the information to a temporary storage; formatting the information; and providing the information for possible inclusion in the list (see col. 4-11).

As to claim 9, Hach teaches the computer-implemented process of claim 1 wherein adding the contact information to the dynamic list comprises adding the contact information to the list if the information has a weight of at least one of equal and greater than contact information already in the list (see 5-12).

As to claim 10, Hach teaches the computer-implemented process of claim 9 wherein information is not added to the list if it is already stored in the list (see col. 5-12).

As to claim 11, Hach teaches the computer-implemented process of claim 9 wherein information is not added to the list if it is already stored in an address book (see col. 5-12).

As to claim 12, Hach teaches the computer-implemented process of claim 9 wherein contact information already in the list is updated by matching contact information extracted from the data store (see col. 5-14).

As to claim 13, Hach teaches computer-implemented process of claim 1 wherein new contact information is added to the list as new information enters the data store (see col. 6-14).

As to claim 14, Hach teaches computer-implemented process of claim 1 wherein entries are dynamically weighted on the number of times that the entries have been used, and how recently the entries have been used (see col. 6-14).

As to claim 15, Hach teaches the computer-implemented process of claim 1 wherein the size of the list is constrained (see col. 6-14).

As to claim 16, Hach teaches the computer-implemented process of claim 1 wherein the size of the list is variable (see co. 6-14).

As to claim 17, Hach teaches the computer-implemented process of claim 15 wherein entries are weighted and wherein entries having greater weights replace entries having equal or lower weights if the list is full (see col. 6-14).

As to claim 18, Hach teaches the computer-implemented process of claim 1 wherein new entries are automatically added to the list after those entries are first used (see col. 6-14).

As to claim 19, Hach teaches the computer-implemented process of claim 1 wherein entries are automatically removed from the list if they are added to an address book (see col. 6-14).

As to claim 20, Hach teaches the computer-implemented process of claim 1 wherein the user interface provides the capability to browse the list (see col. 6-14).

As to claim 21, Hach teaches the computer-implemented process of claim 1 wherein entries from the resolution are selectively added to an address book via a user interface (see col. 6-14).

As to claim 22, Hach teaches the computer-implemented process of claim 1 further comprising automatically suggesting to a user that specific entries from the list be added to at least one of an address book and contact database via the user interface (see col. 6-14).

Claims 23-32 do not teach or define any new limitations above claims 1-22 and therefore are rejected for similar reasons.

4. Applicant's arguments filed November 28, 2003 have been fully considered but they are not persuasive. In the remarks, the applicant argues in substance that; A) Hach does not teach the limitation of dynamically tracking the data store, and that the suggestion lists are not dynamically populated by analyzing and extracting contact information from items within the data store which includes word processor files, spread sheet files, and presentation files; B) Creswell does not disclose the capability to of automatically analyzing and extracting contact information from items within the data store which includes word processor files, spread sheet files and presentation files.

In response to A); Hach discloses that suggestion lists are defined based on dynamic parameters maintained by the computer system including structured data field entries, e-mail address book and that the word completion system may be deployed within an individual application program such as word processor program or email program and alternatively may be deployed within an operating system or an application independence basis such as spread sheet program or personal calendar program (see col. 7-8).

In response to B); a new position is taken with respect to the Hach reference (refer to the rejection of claim 1), Creswell was simply used to modify Hach by including

a data store of items comprising one or more of previously sent e-mail and previously received email as taught by Creswell to update a contact list at a client computer.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saleh Najjar whose telephone number is (703) 308-7613. The examiner can normally be reached on Monday-Friday from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Ario Etienne*, can be reached on (703) 308-7562.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600. The central official fax number for the group is (703) 872-9306.

A handwritten signature in black ink, appearing to read 'Saleh Najjar', with a stylized, cursive script.

Saleh Najjar

Primary Examiner / Art Unit 2157